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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Richard L. Alfvén, et al

**ELECTRONIC IMAGING CAPTURE
AND BILLING DISTRIBUTION
SYSTEM**

Serial No. 09/607,140

Filed 29 June 2000

Commissioner for Patents
P.O. Box 1450
Alexandria, VA. 22313-1450

Sir:

Group Art Unit: 3624

Examiner: Narayanswamy
Subramanian

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APPELLANTS' REPLY BRIEF

On Page 2 of the Examiner's Answer, the Examiner states that "The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or having a bearing on the decision in the pending appeal." Applicants respectfully disagree in that Applicants specifically stated "No appeals or interferences are known which will directly affect or be directly affected by or have bearing on the Board's decision in the pending appeal." It is believed that this expressly states that none are known by Applicants which will directly affect or be directly affected or have a bearing on the decision.

The Examiner in Item 7 on page 3 states "The appellant's statement in the brief that certain claims do not stand or fall together is not agreed with because the claims as listed are not separately patentable."

In this regard Applicants have specifically argued each of the groups setting forth the reasons why they are patentable. Therefore, it is respectfully submitted that the claims in each of the groups stand and fall for reasons set forth in the arguments presented by Applicants.

In response to Examiner's answer, paragraph 1, Applicants respectfully submit that the Examiner has misunderstood the present invention and the cited references. In particular, when references were made to sending of images to a service provider, the service provider is the telecommunication service provider set forth in the claims. Claim 1 as currently set forth, provides:

“a telecommunication service provider providing a telecommunication service to a customer, said telecommunications service provider forwarding a periodic statement for telecommunication services provided to said customer for a predetermined time period;

providing a data base for receiving and storing said digital images from said customer using said combined telecommunications devices to transmit said digital images to said service provider.” [emphasis supplied]

It is clear from the claim that the customer transmits digital images to the telecommunication service provider. Further, as set forth by the preamble, it is clear that the present invention is directed to a method of managing digital images captured by the customer using a combined portable telecommunication and digital image capture device. Thus, it is clear that the images are transmitted by the customer using the combined telecommunication and digital image capture device. In addition, images provided by the customer are stored by the telecommunication service provider. There is no need to read anything from the specification into the claim as the Examiner argues. Applicants respectfully submit that the claims as presented are clear that images are transmitted (sent) by the customer to the service provider where they are stored.

The Examiner cites Reece et al. as disclosed in the feature of providing visual representation of the captured images captured by the customer. This is correct in that the images are displayed on the capture device to the operator of the device. However, Applicants independent claim 1, last paragraph states:

“said telecommunication service provider providing to said customer a visual representation of said captured images taken during said predetermined time period along with said periodic statement.” [emphasis supplied]

Therefore, claim 1 specifically sets forth that it is the telecommunication service provider that provides the visual representation. In the

Reele, et al. reference, there is no service provider that provides visual representation. Quite the contrary, the Reelee et al. reference teaches away from this. In particular, Reelee et al. is directed to a combined electronic/silver halide image capture system having cellular transmission capability. The device, in addition to capturing images on film, also captures images electronically. One of the primary reasons for doing this is that the images can be transmitted to a remote location for preview, see column 1, lines 42-43 and column 6, lines 37-38. It is also clear from column 6, lines 38-41 that the photographic film is used for producing of the prints. Nowhere is it taught or suggested in Reelee et al. that the images are sent to a service provider that stores the digital images. Nowhere is it taught in Reelee et al. that the service provider sends a visual representation of the captured images to the customer along with visual representations. The reference by Examiner to column 5, lines 11-18 of Reelee et al. simply discloses that the operator of the capture device may review the images on the device.

Applicants for the above reasons and reasons set forth in the Appeal Brief, believe that the Reelee et al. reference is of little relevance to the present invention.

The Examiner also cites the Kolling et al. reference for the step of providing periodic statements for telecommunication service along with custom enclosures. The Examiner cites various passages in Kolling for the proposition that the custom enclosures include visual representation of captured images. However, these are not images captured by the customer. As set forth in independent claim 1, the telecommunication provider provides to the customer a visual representation of the captured images. The captured images refer to the images that were captured by the customer and transmitted to the service provider above. There is nothing in Kolling that teaches or suggests that the billing system includes images captured by the customer. Kolling merely discloses providing of an electronic statement to a user.

In determining the motivation to combine references, Applicants respectfully refer to *In re Lee* 277 Fed 1338 61 USPQ 2d, 1430 (Federal Circuit 2002). The central question is whether there is a reason to combine the references. The factual inquiry whether to combine references must be thorough and searching. It must be based on objective evidence of record. The Court at 1433 stated:

“Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art referencesteachings of references can be combined only if there is some suggestion or incentive to do so .”

The court at page 1434 stated:

“the examiner can satisfy the burden of showing obviousness of the combination only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references”

As previously described, Reeley et al. is simply directed to transmitting images from one point to another. Kolling is directed simply to providing a billing system. Nowhere in either of those references would it teach or suggest one to combine one with the other. Further, the problem to which the present invention is directed is neither present or even applicable in either of the cited references. In particular, as previously discussed in Applicants Brief, the amount of image storage that can be maintained in a capture device is limited. The user of digital cameras make it easy for it to capture hundreds of images in a very short period of time. The present invention provides the system to assist in managing these images by combining the services of a telecommunication provider that can store and fulfill image orders.

The Examiner states that Reeley et al. teach a method and system for respectively managing digital images captured by a customer using a combined portable telecommunication digital capture device. As previously noted, there is no managing of any images by a service provider in Reeley, et al. Quite the contrary, Reeley et al. merely discloses the transmissions of images from one point to another point. There is no storing of images in Reeley et al. Reeley et al. at column 1, lines 56-59 merely states “The system includes a camera unit and cellular telephone that can be electrically coupled to the camera unit or, alternatively, a single module that integrates the camera unit and cellular telephone unit.” Applicants fail to understand how this teaches or suggests storing or managing of images. Further, as previously discussed, there is no teaching that images are sent (transmitted) to a service provider. The reference at column 5, lines 25-43 utilized by the Examiner merely discloses the ability to

have images previewed at a remote location. There is no managing and there is no storing of digital images.

The Examiner also makes the statement that it is unrealistic to expect a telecommunication service provider to provide such services for free in the long run. Applicants respectfully submit that this statement is unsupportable and is not made based on any teaching or suggestion in the prior art. Applicants would like to point out that there are services out there that store images indefinitely and do not charge for such storage. An example of this is the Ofoto.com where images are stored on behalf of customers without charge for an indeterminate period of time. Thus, the statement that it is unrealistic to expect a telecommunication service to provide such service is unsupportable. Further, the statement that hence billing the customer for services provided is a natural progression of the disclosure of Reeley et al. is not understood. What is being billed in the present invention are telecommunication services and that along with that are provided captured images that the customer may order if so desired. Kolling merely discloses the providing of billing. Again, there is no common problem in either of these references that would teach or suggest the combining them nor do they solve the problem to which the present invention is directed.

The Examiner relies on the combining of two references that it would save for the managing of both transactions, i.e. providing the periodic billing statement and providing the visual representations. However, the present invention is directed to more than this as previously discussed. It is directed to managing and storing multiple images captured by the images on behalf of a customer. There is no teaching or suggestion of managing images in the method set forth by Applicants. To make the statement that the motivation to combine is old and well known is not based on any teaching or suggestion of the prior art.

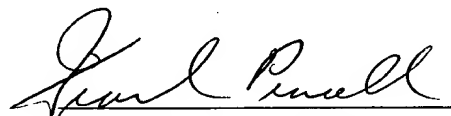
With regard to the rejection of claims 3 and 7, three distinct references were cited. The addition of Enomoto et al. was provided by the Examiner in support of providing on-line ordering. While the Examiner may be correct in that it does disclose the on-line ordering of images, this is not what the present invention is directed to. The present invention is directed to managing images captured by a customer in a manner that is efficient for the customer. As previously discussed, the Reeley, Kolling and Enomoto references are directed to three totally different business areas and the combining of these are not taught or

suggested as the problems of each of the cited references are totally apart and distinct and there is no motivation in any of the cited references to make the combination suggested by the Examiner. The Examiner, with regard to rejecting claims 4-6 states that "If a telecommunication services provider provides multiple products or services it would make sense to combine the transactions together so as to achieve integrated record keeping and providing the customer the convenience of paying one bill instead of separate bills." While this is subject to argument, the present invention is not directed to paying of a single bill but instead for managing large number of images that may be captured by a customer. Further, it is not necessarily obvious that providing of multiple products or services would be provided in a single bill. Further, it is only speculative if a service provider provides an image management and telecommunication services. There is nothing in the prior art that teaches the providing of such.

With regard to paragraph 4 of the Answer with respect to claims 15 and 16, Applicants respectfully submit that it is the combined ordering of image goods and services and the payment of telecommunication services to which these claims are directed. The prior art fail to teach or suggest this.

In summary, Applicants respectfully submit that the claims in their present form are in condition for allowance. Applicants accordingly request that the Board direct the Examiner to allow the claims as currently set forth.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Frank Pincelli", written over a horizontal line.

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